

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of
Richard HERTZOG et al.

Application No: 08/601,879

Group Art Unit: 1205

Filed: February 15, 1996

Examiner: J. Reamer

For: DECOMPOSITION OF CUMENE OXIDATION PRODUCT

PETITION TO THE COMMISSIONER UNDER 37 CFR 1.181

MAR 12 1997

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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Sir:

Petition is hereby taken to the Commissioner to invoke his supervisory authority to rectify inconsistent and inadequately explained actions by the Examiner which are highly prejudicial to applicants' assignee.

I. SUMMARY OF ACTION REQUESTED.

The Examiner should be directed to treat claims 10-14, 16-18 and 20 of the present application, consistently with claims directed to the same subject matter in Reexamination Serial No. 90/004314. Whereas the Examiner has found this subject matter to be obvious over the prior art to the present applicant, the same Examiner has found this subject matter to be allowable to another party in Reexamination Serial No. 90/004314, even though the present claims are entitled to a much earlier effective filing date.

II. STATEMENT OF FACTS.

The following is a statement of material facts, set forth in numbered paragraphs.

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(1) In an Official Action (Paper No. 6), mailed January 23, 1997, in Reexamination Serial No. 90/004314 (hereinafter SN 90/004314), Examiner J. Reamer allowed claims 1-10, 12-20, 22-36 and 38.

(2) A number of the allowed claims in SN 90/004314 correspond to claims of the above-identified application, which were added to provoke an interference with the patent (i.e. US 5,254,751). More particularly, this correspondence is as follows:

<u>PRESENT CLAIM</u>	<u>REEXAM CLAIM</u>
9	1
10	4
11	7
12	8
13	9
14	10
16	32
17	33
18	34
20	38

(3) In an Advisory Action, mailed January 30, 1997, in the present application, the same Examiner J. Reamer refused to withdraw his rejection of the above-mentioned claims 10-14, 16-18 and 20 of the present application.

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(4) The present claims 10-14, 16-18 and 20 are entitled to an effective filing date of January 17, 1989.

(5) The allowed claims of SN 90/004314 are entitled to an effective filing date no earlier than September 14, 1992.

(6) The present claims 10-14, 16-18 and 20 were copied in a timely manner¹ for the purposes of provoking an interference with the corresponding claims of the Zakoshansky U.S. Patent No. 5,254,751, now the subject of SN 90/004314.

(7) Support for the recitations of the present claims 10-14, 16-18 and 20 in the specification is clearly pointed out in the Preliminary Amendment, filed February 28, 1994. The Examiner has never alleged that the present claims 10-14, 16-18 and 20 are not supported by the specification.

(8) In a Preliminary Amendment, filed May 2, 1996, in the present application, it was pointed out that the present claims 10-14, 16-18 and 20 corresponded to issued claims of US 5,254,751. Since these claims were found to be allowable in US 5,254,751, it was argued that they should be found allowable in the present application. MPEP 704 and MPEP 706.04.

¹ The Zakoshansky U.S. Patent No. 5,254,751 issued on October 19, 1993, and the present claims 10-14 and 16-20 were initially presented in a Preliminary Amendment, filed February 28, 1994.

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(9) In said Preliminary Amendment, filed May 2, 1996, the following statement in the final rejection in the parent application was also noted:

"Moreover, these claims are based on the same disclosure as the originally rejected claims and are read in the light of this disclosure. The claims of Zakoshansky are also read in the light of his disclosure which differs from the instant disclosure."

In said Preliminary Statement it was pointed out that meaning and significance of this statement was not understood. Applicants specifically requested that this statement should not be repeated or otherwise relied upon in the present application unless clarified.

(10) In said Preliminary Amendment, filed May 2, 1996, an interview with the Examiner, pursuant to MPEP 713.02, was specifically requested, in a good faith effort to resolve and/or clarify issues. However, such an interview was never granted. The Examiner did not contact applicants' representative by telephone or otherwise to set up an interview. Instead, the Examiner mailed a first action, final rejection on August 28, 1996.

(11) In the first Official Action on the merits, mailed August 28, 1996, made final, in the present application, the

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present claims 10-14, 16-18 and 20 were rejected under 35 USC 103 over the disclosure of the Sifniades U.S. Patent No. 4,358,618 in combination with the disclosure of the Anderson et al U.S. Patent No. 4,207,264 and the disclosure of the Barilli British Patent No. 1,202,687.²

(12) The reasons for rejecting the present claims 10-14, 16-18 and 20 are set forth in the final rejection, mailed August 28, 1996, as follows:

"The inclusion of claims 9 to 25 in the rejection is considered to be proper, even though there claims are presented to invoke an interference, since these claims are read in light of the instant disclosure and not the disclosure of the patent to Zakoshansky. These claims when read in light of the instant disclosure are not seen to overlap the claims of Zakoshansky."

(13) In the Amendment, filed December 30, 1996, in response to this final rejection, it is pointed out that the present claims

² The Sifniades et al U.S. Patent No. 4,358,618 and the Barilli British Patent No. 1,202,687 are specifically of record in SN 90/004314. Examiner Reamer is also no doubt aware of the disclosure the Anderson et al U.S. Patent No. 4,207,264, but this patent has not been made of record in SN 90/004314.

do overlap with the claims of "Zakoshansky" (i.e. US 5,254,751).³

(14) As pointed out hereinabove, in paragraph (1), in an Official Action (Paper No. 6), mailed January 23, 1997, in SN 90/004314, Examiner J. Reamer allowed claims 1-10, 12-20, 22-36 and 38.

(15) As pointed out hereinabove, in paragraph (3), in an Advisory Action, mailed January 30, 1997, in the present application, the same Examiner J. Reamer refused to withdraw his rejection of the above-mentioned claims 10-14, 16-18 and 20 of the present application.

III. POINTS TO BE REVIEWED.

The following is a statement of points to be reviewed, set forth in numbered paragraphs.

(1) The Examiner has acted in an inconsistent manner by allowing claims 1-10, 12-20, 22-36 and 38 in SN 90/004314, while, at the same time, rejecting the corresponding claims 10-14, 16-18 and 20 in the present application.

(2) The Examiner has prematurely made a final rejection in the first official action of the merits.

³ Even though these claims were first copied from US 5,254,751 on February 28, 1994, the final rejection is the first time that the Examiner alleges that there is no "overlap" in the claims.

IV. PROCEDURAL VIOLATIONS.

Since the present claims 10-14, 16-18 and 20 were introduced in accordance with the above-mentioned Preliminary Amendment, filed February 28, 1994, these claims have never been subjected to a proper examination. To the contrary, these claims have merely been summarily rejected without a proper recitation of reasons therefor. These problems have been exacerbated by the recent allowance of corresponding claims to the competitor of applicants' assignee in SN 90/004,314.

Since February 28, 1994, a period of three years, there have been considerable repeated violations within the letter and spirit of Title 37 of the Code of Federal Regulations, as well as the provisions of the Manual of Patenting and Examining Procedure.

A. Violations of 37 CFR 1.104(a).

As required by 37 CFR 1.104(a), the Examiner shall make a thorough study of an application. Such a thorough study has clearly not been made in the present application.

From the facts recited above, it is apparent that claims in the present application have been summarily rejected without a proper consideration of the subject matter. How can the same Examiner find this subject matter to be free of the prior art in Serial No. 90/004314, while finding this subject matter obvious in the present application?

B. Violations of 37 CFR 1.104(b).

As required by 37 CFR 1.104(b), the Examiner shall provide reasons for a rejection in a manner which is useful in aiding the applicant.

As pointed out in the Preliminary Amendment, filed August 28, 1996, the Examiner's reasons for rejecting claims 10-14, 16-18 and 20 make absolutely no sense. In particular, prior to the final rejection, the Examiner had stated as follows:

"Moreover, these claims are based on the same disclosure as the originally rejected claims and are read in the light of this disclosure. The claims of Zakoshansky are also read in the light of his disclosure which differs from the instant disclosure."

As pointed out to the Examiner in said Preliminary Amendment, the terms of the present claims are regarded to be sufficiently clear as to not require reference to a specification for interpretation. MPEP 608.01. In an effort to clarify the record, the Examiner was challenged to specifically point out, for each and every claim, the differences between applicants' disclosure and that of the Zakoshansky patent, which would render the subject matter of the present claims patentable to Zakoshansky but not to

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the present applicants. The Examiner has not and cannot meet this challenge.

In the final rejection, mailed August 28, 1996, the Examiner stated as follows:

"The inclusion of claims 9 to 25 in the rejection is considered to be proper, even though there claims are presented to invoke an interference, since these claims are read in light of the instant disclosure and not the disclosure of the patent to Zakoshansky. These claims when read in light of the instant disclosure are not seen to overlap the claims of Zakoshansky."

Rather than clarify the earlier statement, this latter statement merely repeats the earlier statement, while alleging for the first time that the present claims do not even "overlap" the corresponding claims of Zakoshansky.⁴ This allegation is totally without merit, and suggests that the Examiner has made far less than a "thorough study" of the respective claims.

⁴ Although the present claims use slightly different wording to express the quantity of the excess acetone, the "overlap" of the presently claimed ranges with those of SN 90/004314 was clearly pointed out to the Examiner in the Preliminary Amendment, filed February 28, 1994. More particularly, near the bottom of page 4, it is pointed out that 10 to 100 percent in excess of acetone corresponds to a molar ratio of acetone to phenol equal to from about 1.1:1 to 2.0:1.

C. Violations of MPEP 713.02.

In the Preliminary Amendment, filed May 2, 1996, an interview with the Examiner, pursuant to MPEP 713.02, was specifically requested, in a good faith effort to clarify and/or resolve issues. However, such an interview was never granted. The Examiner did not contact applicants' representative by telephone or otherwise to set up an interview. Instead, the Examiner mailed a first action, final rejection on August 28, 1996.

V. RELIEF REQUESTED.

In the interests of justice, the present claims 10-14, 16-18 and 20 should be treated consistently with the corresponding claims in SN 90/004314. Insofar as these claims have been allowed in SN 90/004314, the present claims 10-14, 16-18 and 20 should also be allowed for the purposes of a declaration of an interference.

Since these claims have been allowed over the prior art to the competitor of applicants' assignee, any questions regarding the patentability of claims should be taken up on an interparties basis. The present course of allowing the claims to said competitor⁵, while forcing the present applicant to combat rejections made for incomprehensible reasons, is extremely unfair to applicants'

⁵ It is noted that these claims were allowed even though the Order (Paper No. 5), mailed September 23, 1996, in SN 90/004314 indicated that there was a substantial question of patentability for these claims over the prior art listed in the reexamination request. See the first full paragraph on page 5 of said Order.

assignee. If any party is to carry a larger burden in establishing patentability over the prior art, it should be the applicant of SN 90/004413, because the present application is entitled to a much earlier effective filing date.

VI. TIMELINESS OF THIS PETITION.

Pursuant to 37 CFR 1.181(f), a petition must be filed within two months of action complained of. This petition is timely, because actions complained of were made on January 30, 1997, in the Advisory Action, wherein the Examiner refused to allow the present claims, and on January 23, 1997, wherein the Examiner allowed corresponding claims in SN 90/004314.

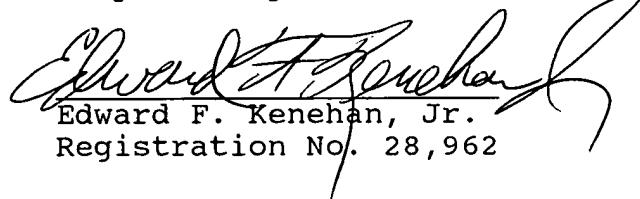
Pursuant to 37 CFR 1.181(c), this petition is further timely, because the Examiner has repeatedly been requested to take action as described herein.

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VII. EXPEDITED RELIEF IS URGENTLY SOLICITED.

Any further delay in resolving this matter may be highly
damaging to applicants' assignee.

Respectfully submitted,


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